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AUG 11 2004

In re Application of :
Joseph Roberts et al :
Application No. 09/972,245 :
Filed: October 9, 2001 :
Attorney Docket No. 078728-0104 :

OFFICE OF PETITIONS

ON PETITION

This is a decision on the petition under 37 CFR 1.78(a)(6), filed June 1, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of prior-filed provisional Application No. 60/239,268, filed October 12, 2000.

The petition is **DISMISSED AS MOOT**.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000.

Petitioner has submitted on June 1, 2004, an amendment to the first sentence of the specification following the title to include a reference to prior-filed provisional Application No. 60/239,268, filed October 12, 2000.

The instant pending nonprovisional application was filed on October 9, 2001, and was pending at the time of filing of the instant petition. While a reference to the prior-filed provisional application was not included in an ADS or in the first sentence of the specification following the title, reference nevertheless was made in the transmittal letter filed with the above-identified application.

The current procedure where a claim for priority under 37 CFR 1.78(a)(6) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR 1.78(a)(5). However, on the other hand, if the USPTO does not note the claim for priority to the provisional application in the oath or declaration or transmittal letter submitted with the

application, a petition will be required to accept a late claim for priority under 37 CFR 1.78(a)(6).¹ In the instant case, the Office noted the claim for priority of provisional Application No. 60/239,268 in the declaration filed with the application, as shown by its inclusion on the filing receipt.

In view of the above, the \$130 petition fee submitted is unnecessary and will be refunded to petitioner's deposit account in due course.

Additionally, a reference to add the above-noted, prior-filed application on page one following the first sentence of the specification has been included in a concurrently filed amendment. However, the amendment as drafted is unacceptable. In order for the incorporation by reference statement to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application. See *In re deSeversky, supra*. Note also MPEP 201.06. Therefore, applicant must file a substitute amendment deleting the incorporation by reference statement for the prior-filed provisional application.

Any questions concerning this decision on petition may be directed to Karen Creasy at (703)305-8859. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being referred to Technology Center AU 1755 for consideration by the examiner of the claim under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(6) for the benefit of prior-filed provisional Application No. 60/239,268, filed on October 12, 2000.



Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

¹ Note 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.